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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Applicant: DaCosta	)	Art Unit: 2614
	)	
Serial No.: 10/782,265	)	Examiner: Beliveau
	)	
Filed: February 19, 2004	)	50T5776
	)	
For: SYSTEM AND METHOD FOR PROVIDING	)	May 8, 2006
CONTENT LIST IN RESPONSE TO SELECTED	)	750 B STREET, Suite 3120
CLOSED CAPTION WORD	)	San Diego, CA 92101
	)	

**REPLY BRIEF**

Commissioner of Patents and Trademarks

Dear Sir:

This Reply brief responds to the Examiner's Answer dated May 3, 2006.

The Answer declares that Appellant has "conceded" any arguments not made in the Appeal Brief. From the very beginning of prosecution, Appellant has made clear that "the fact that Applicant has focussed its comments distinguishing the present claims from the applied references and countering certain rejections must not be construed as acquiescence in other portions of rejections not specifically addressed", response dated June 27, 2005.

The Answer concedes Appellant's point that in Brodsky, words are added to a dynamically evolving dictionary, and a user later can speak words that are matched to words in the dictionary for obtaining additional content - but it continues to avoid allowance by equating this automatically-generated partial list with something different, namely, words "within" CC, on the ground that since the words in the partial list

1168-117.RPL

CASE NO.: 50T5776  
Serial No.: 10/782,265  
May 8, 2006  
Page 2

PATENT  
Filed: February 19, 2004

are contained in televised content, then that is the same thing as what is being claimed. However, this allegation fails to rise to a reason to make words within closed captioning text itself appear differently from other words, as set forth in, e.g., Claim 1, because the words in Brodsky are not selected by a human for addition to the dictionary but by a machine instead.

The Answer continues the "dog/cat" line of reasoning with a series of Socratic questions without asking the one most germane: if, under the dog/cat logic, every word is a primary word because it is spelled differently than every other word, why is the claimed invention not rendered superfluous? A claim interpretation that has the effect of depriving a claim term of a limiting meaning is contrary to law, Innova/Pure Water, cited in the Appeal Brief.

The Answer appears to concede that combining Sampsell with the above three references would not result in Claim 3, evidently relying on how one skilled in the art would reconstruct the references to arrive at a combination that is different than that which would result from the teachings of the references themselves. However, the logic employed in the Answer to go beyond the teachings of the references, while purporting not to be gleaned from the specification, in fact is not gleaned from the references either. In essence, the Answer observes that the references *can* be modified to arrive at Claim 3 without recognizing that the mere fact that a reference can be modified does not render an invention obvious, unless the modification is suggested by the prior art, In re Mills, cited in MPEP §2143.01. In the present case, there is no suggestion in Brodsky to display anything on a remote control device, and there is no suggestion in Sampsell to display a list of anything, much less of content related to a selected word, on its remote control.

Appellant continues to assert that various other obviousness rejections run afoul of the law, and incorporates arguments contained in the Appeal Brief. By way of non-limiting example, the Answer begins

1168-117.RPL

CASE NO.: 50T5776  
Serial No.: 10/782,265  
May 8, 2006  
Page 3

PATENT  
Filed: February 19, 2004

its defense of the rejection of Claim 10 with a disingenuous opening, alleging that Appellant, in arguing that Claim 10 allows a head-end provider to direct attention to primary words, is arguing features that are not in the claim. But Claim 10 requires a TV to receive content *from a source*, and that the content includes closed caption text with at least one word within the closed caption text being made to flash within the closed caption text. Thus, while Appellant's argument is not crafted in exactly the same language, it is difficult to understand why the examiner thinks that Appellant is arguing features beyond the scope of the claims.

The Answer then descends into psychoanalysis to explain the rejection, conjecturing that a story about invading aliens would "involve an emotional response on the part of the speaker" to thereby cause words to flash. Appellant, not being trained in either psychoanalysis or space aliens, cannot scientifically respond to this interesting speculation. Accordingly, Appellant must return, like a one-trick pony, to the realm of the law of obviousness, in that there is no psychiatric test for patentability known to Appellant. There is only 35 U.S.C. §103 and case law descending therefrom, which forces the observation that there is no motivation in Thomsen to cause any word to appear differently from any other word in the CC that is received from the head end, nor is there any apparent emotion requiring expression in Thomsen.


Appellant's explanations as to the defects in the remaining rejections retain their vitality, and will not be rehashed in this brief.

1158-117.RPL

CASE NO.: 50T5776  
Serial No.: 10/782,265  
May 8, 2006  
Page 4

PATENT  
Filed: February 19, 2004

Respectfully submitted,

  
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John L. Rogitz  
Registration No. 33,549  
Attorney of Record  
750 B Street, Suite 3120  
San Diego, CA 92101  
Telephone: (619) 338-8075

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1168-117.RPL